

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**Docket Number:
053785-5120

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on _____

Signature _____

Typed or printed
Name _____Application Number:
10/603,990Filed:
June 26, 2003First Named Inventor:
Mi-Sook NAM, et al.Art Unit:
2871Examiner:
T. Chowdhury

Applicant(s) request(s) review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages are provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

☒

attorney or agent of record.

Registration number 41,480☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____


SignatureKyle J. Choi
Typed or printed name(202)739-3000
Telephone numberAugust 18, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 form is submitted.



**Response Under 37 C.F.R. § 1.116
Expedited Procedure
Examining Group 2871**

PATENT
Attorney Docket No. 053785-5120

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Mi-Sook NAM, <i>et al.</i>)	Confirmation No. 3882
Application No.: 10/603,990)	Group Art Unit: 2871
Filed: June 26, 2003)	Examiner: T. Chowdhury
For: TRANSREFLECTIVE LIQUID CRYSTAL)	
DISPLAY DEVICE AND FABRICATING)	MS: AF
METHOD THEREOF)	

U.S. Patent and Trademark Office
Customer Window, Mail Stop AF
Alexandria, VA 22314

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In response to the final Office Action of June 1, 2006, Applicants respectfully request for a pre-appeal brief review of the pending rejections. A Notice of Appeal is filed concurrently herewith.

Independent claim 1 recites, in part, “a plurality of uneven patterns *consisting of* a first organic material layer within the reflective portion, the uneven patterns *partially covering* the substrate.” Similarly, independent claim 12 recites, in part, a step of “forming a plurality of uneven patterns *consisting of* a first organic material layer within the reflective portion...the uneven patterns *partially covering* the substrate.” (Emphasis added.) Independent claim 12 recites similar features. Applicants assert that Okamoto et al., Zhang et al., and Kobashi, whether taken individually or in combination, fail to teach or suggest at least these features.

As explained more in detail in the after final amendment filed August 29, 2005 and incorporated herein by reference, Okamoto et al. discloses that the organic material layer 25

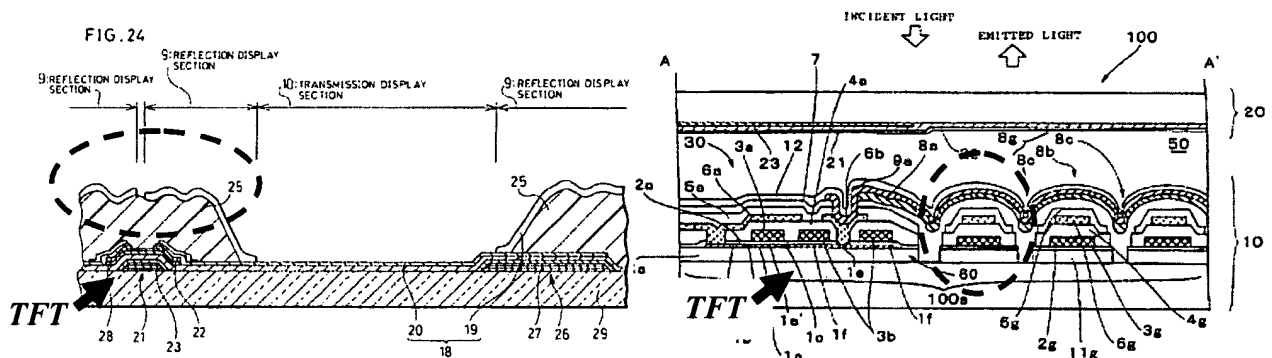
within the reflective

portion 9 **fully covers** the substrate. (AF Amdt: p. 11, 2nd full paragraph.) In the final Office Action, the Office asserts that “because the Okamoto reference discloses that the organic material layer (25) in the reflective (9) fully covers the substrate, it also, by definition, covers the substrate ‘partially.’” (FOA: p. §5, ¶2.) Applicants disagree. “Fully covered” and “partially covered” cannot and is not, by definition, the same. As stated before, “partially covering” necessarily requires covered portions and uncovered portions while “fully covering” involves covered portions only. Hence, a “fully covering” organic material layer 25 cannot reasonably be construed as “partially covering” the substrate since fully covering does not include uncovered portions.

In the final Office Action, the Office asserts that “as applicant correctly pointed out, ‘partially covered’ is a subset of ‘fully covered’ and thus ‘fully covered’ also reads on the limitation of ‘partially covered.’” (FOA: p. 6, §5, ¶2.) Applicants assert that the alleged admission is taken completely out of context and that no such admission has ever been made. In the response filed March 21, 2006, Applicants asserted that “[i]t appears that the **Office is suggesting** that ‘partially covered’ is a subset of ‘fully covered,’ and therefore a ‘partially covered’ limitation is encompassed in a ‘fully covered’ limitation. **Applicants disagree.**” (Emphasis added; RFR: p. 3, ¶2.) Moreover, in the final Office Action, the Office alleges that “applicant’s arguments such as, ‘partially covering’ requires covered portions and uncovered portions is not relevant since the claim limitations does not recite that.” However, it is reminded that the Office considered “uncovered portions” as a feature when applying Kobashi as a

reference. (See, e.g., FOA: p. 3, last paragraph.) If covered and uncovered portions are irrelevant in construing the term “partially covering,” it is not understood why the Office gave it weight in producing a secondary reference to modify the primary reference. Applicants assert that by considering such a feature for purposes of producing prior art but disregarding the same in order to justify the combination is necessarily inconsistent and improper.

As presented in the previous response, Applicants also reassert that it would not have been obvious for one with ordinary skill in the art to have modified Okamoto et al. to include uneven patterns consisting of a first organic material layer within the reflective portion based on Kobashi’s teachings. FIG. 24 of Okamoto et al. and FIG. 5 of Kobashi are reproduced respectively below.



In the final Office Action, the Office construes organic layer 25 as the recited “a plurality of uneven patterns consisting of a first organic material layer.” In order to meet the limitation of “the uneven patterns partially covering the substrate,” the Office asserts that it would have been obvious to modify Okamoto et al.’s organic layer 25 to include the uneven patterns of Kobashi. The uneven patterns of Kobashi (i.e., elements 2g, 3g, 4g, 5g, 6g, and 11g) are materials left over

during the formation of the TFT and therefore the uneven patterns are necessarily formed in the *same plane*. In contrast, Okamoto et al. teaches forming the uneven patterns *over* of the TFT. MPEP §2143.01 states that “[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.” Here, one with ordinary skill in the art would not have been motivated to modify Okamoto et al. with Kobashi’s uneven patterns as asserted in the final Office Action as it is impossible to create the uneven patterns of Kobashi in the device of Okamoto et al. as explained above. It is clear that the uneven patterns of elements 2g, 3g, 4g, 5g, 6g, and 11g, which is construed to correspond to the “uneven patterns” recited in the present claims, cannot be created over the TFT of Okamoto et al. as the uneven patterns are created from portions left over while forming the TFT.

Furthermore, Applicants note once again that independent claim 1 recites, in part, “a plurality of uneven patterns *consisting of* a first organic material layer within the reflective portion, the uneven patterns partially covering the substrate” (emphasis added) and independent claim 12 recites, in part, a step of “forming a plurality of uneven patterns *consisting of* a first organic material layer within the reflective portion...the uneven patterns partially covering the substrate” (emphasis added). By contrast, Kobashi teaches uneven patterns formed of *multiple layers*. In the final Office Action, the Office states that “[f]irst, it is unclear what Applicant’s argument is” and “[s]econd, even if Applicant’s argument can be properly and logically understood, it is noted that there is nothing in Kobashi reference and *nothing in the claims to*

preclude the multiple layers formed over the TFT of Kobashi is not inclusive of a first organic material layer.” (Emphasis added; FOA: p. 7.) It is reminded that transitional phrases are one of the basic tools for defining the scope of a claim. As explained in MPEP §2111.03, “consisting of” *excludes* any element, step, or ingredient not specified in a claim. Yet, the Office alleges that there is nothing in the claims to preclude the multiple layers of Kobashi to include a first organic material layer.

In view of the foregoing, Applicants respectfully submit that the rejections made in the final Office Action are in error and therefore should be withdrawn. If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

Dated: August 18, 2006

By: 

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